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PATENT APPLICATION

ATTORNEY DOCKET NO. 10006507-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Quintin T. Phillips et al.

Confirmation No.: 4805

Application No.: 09/932,237

Examiner: John W. Van Bramer

Filing Date: August 16, 2001

Group Art Unit: 3622

Title: Article of Manufacture and Marketing Methods

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 12, 2007.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.26. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.☒ A duplicate copy of this transmittal letter is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Rev 10/06a (AptBrief)

Respectfully submitted.

Quintin T. Phillips et al.

By 

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg No.: 39.833

Date: 5/14/07

Telephone: 509/624-4276

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Inventor..... Quintin T. Phillips et al.
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 3622
Examiner.....John W. Van Bramer
Attorney's Docket No..... PDNO. 10006507-1
Confirmation No..... 4805
Title:Article of Manufacture and Marketing Methods

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
Wells, St. John, P.S.
601 W. First Avenue, Suite 1300
Spokane, WA 99201-3817

Appellant appeals from the Final Office Action mailed December 12, 2006 (hereinafter "Office Action" or "Action"). The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

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I. REAL PARTY IN INTEREST

The real party in interest of this application is Hewlett-Packard Development Company, L.P. as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012272, Frame 0158, and the full assignment to Hewlett-Packard Development Company, L.P. recorded starting at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. The Hewlett-Packard Development Company, L.P., is a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-25 are pending and stand rejected. Appellant appeals the rejection of claims 1-25.

IV. STATUS OF AMENDMENTS

No amendments have been filed since the mailing of the Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to independent claim 1, memory 22 may include media configured to store code configured to cause processing circuitry 28 to perform steps

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according to one embodiment. Providing a message is described with respect to Fig. 6, for example, at step S32 and page 15, line 14 of the specification, in one embodiment. Monitoring is described in one embodiment at step S60 of Fig. 7 at page 17, line 5. Enabling communication of a message is described at step S68 of Fig. 7 at page 17, line 18 of one embodiment.

Referring to dependent claim 2, monitoring coupling of a consumable and an image forming device is described at step S60 of Fig. 7 and described at page 17, line 5 according to one embodiment.

Referring to dependent claim 3, memory device 36 including a message which is accessed is described at page 16, line 17 according to one embodiment.

Referring to dependent claim 4, memory device 36 including an identifier which is accessed is described at page 16, line 20 according to one embodiment.

Referring to dependent claim 21, detection of coupling of a consumable and enabling is described in Fig. 5 and at page 13, line 27 according to one embodiment.

Referring to independent claim 8, a consumable is described at page 5, line 26 according to one embodiment. Making available a marketing function is described at step S10 of Fig. 4 and page 13, line 6 according to one embodiment. Receiving an indication to utilize the marketing function is described at step S12 of Fig. 4 and page 13, line 10 according to one embodiment. Enablement of the marketing function is described at a step S14 of Fig. 4 and page 13, line 19 according to one embodiment. Initiation of a marketing function is described at page 12, line 8 and at step S60 of Fig. 7 at page 17, line 5 according to one embodiment.

Referring to dependent claim 12, detecting triggering events are described at page 12, line 5 according to one embodiment.

Referring to dependent claim 13, communication of a message is described at step S68 of Fig. 7 at page 17, line 18 of one embodiment.

Referring to dependent claim 14, detecting coupling of a consumable and an image forming device is described at step S60 of Fig. 7 and described at page 17, line 5 according to one embodiment.

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Referring to dependent claim 16, description of a consumable configured to enable the marketing function is provided at page 14, line 13, according to one embodiment. A consumable having memory which includes a marketing message is described at page 14, line 13 and page 15, line 12 according to one embodiment. Storing the marketing message is described at page 10, line 11 according to one embodiment. Accessing the marketing message and communicating the message are described at page 15, line 14 at step S32 and page 16, line 23 according to one embodiment.

Referring to dependent claim 17, memory device 36 of a consumable including an identifier and accessing the identifier is discussed at step S34 and page 15, line 22 according to one embodiment. Association of a consumable with the image forming device is discussed at page 13, line 27 according to one embodiment. Communication of the identifier is discussed at page 15, line 23 according to one embodiment. Receiving the message is described at page 15, line 27 according to one embodiment. Communicating the message is described at page 16, line 23 according to one embodiment.

Referring to dependent claim 18, monitoring of a consumable using an external device is described at page 9, line 29 and page 11, line 31 according to one embodiment. Forwarding a marketing message responsive to status is described at page 12, line 1 according to one embodiment. Communicating the message is described at page 16, line 23 according to one embodiment.

Referring to dependent claim 19, offering space of a memory device of a consumable is described at page 13, line 5 according to one embodiment.

Referring to independent claim 20, description of a consumable configured to enable the marketing function is provided at page 14, line 13, according to one embodiment. Offering is described at page 13, line 5 according to one embodiment. Receiving an indication to utilize the marketing function is described at step S12 of Fig. 4 and page 13, line 10 according to one embodiment. Enablement of the marketing function is described at a step S14 of Fig. 4 and page 13, line 19 according to one embodiment. Detecting triggering events is described at page 12, line 5 according to one embodiment. Initiation of a marketing function

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is described at page 12, line 8, at step S60 of Fig. 7 and at page 17, line 5 according to one embodiment.

Referring to dependent claim 21, association of a consumable with the image forming device and enablement is discussed at page 13, line 27 according to one embodiment.

Referring to dependent claim 22, storing the marketing message is described at page 10, line 11 according to one embodiment.

Referring to dependent claim 23, storing the marketing message is described at page 10, line 11 according to one embodiment.

Referring to dependent claim 24, storing an identifier is described at page 16, line 20 according to one embodiment.

Referring to dependent claim 25, communicating the message using image forming device 12 is described at page 16, line 23 according to one embodiment.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 102 rejection of claims 1-7 and 21 over Shimbori.
- B. The 102 rejection of claim 8-19 and 22-24 over Shimbori.
- C. The 102 rejection of claims 20 and 25 over Shimbori.
- D. The 102 rejection of claim 2 over Shimbori.
- E. The 102 rejection of claim 3 over Shimbori.
- F. The 102 rejection of claim 4 over Shimbori.
- G. The 102 rejection of claim 21 over Shimbori.
- H. The 102 rejection of claims 12-15 over Shimbori.
- I. The 102 rejection of claim 13 over Shimbori.
- J. The 102 rejection of claim 14 over Shimbori.
- K. The 102 rejection of claim 16 over Shimbori.

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- L. The 102 rejection of claim 17 over Shimbori.
- M. The 102 rejection of claim 18 over Shimbori.
- N. The 102 rejection of claim 19 over Shimbori.
- O. The 102 rejection of claim 22 over Shimbori.
- P. The 102 rejection of claim 23 over Shimbori.
- Q. The 102 rejection of claim 24 over Shimbori.
- R. The 102 rejection of claim 25 over Shimbori.

VII. ARGUMENT

A. Appellants respectfully submit that positively recited limitations of claims 1-7 and 21 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

In the first Office Action dated June 29, 2007, the Office relied upon the teachings of paragraph 0044 of Shimbori as allegedly teaching the claimed monitoring of the association of the consumable with the image forming device in support of the rejection.

Appellants respectfully submit that monitoring of the association of the consumable and the image forming device as claimed is not disclosed by the monitoring of the remaining amount of consumables of paragraph 0044 of Shimbori. Shimbori teaches monitoring the capacity of the consumable with no evidence that the information regarding only the consumable provides any information regarding an association of the consumable with the image forming device as claimed. Appellants respectfully submit that monitoring a capacity of the consumable fails to teach or suggest monitoring the association of the consumable and the image forming device as claimed.

At page 11 of the final Office Action dated December 12, 2006, the Office now also relies upon the teachings of paragraph 0047 of Shimbori in addition to the teachings of paragraph 0044. However, the teachings of paragraph 0047 refer to a

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printer monitoring unit 110 which monitors whether or not the printing has been finished normally, and whether or not paper that has been used in the printing was correct paper. Appellants respectfully submit that the monitoring of whether printing was finished normally and whether the paper was the correct type fails to teach or suggest the claimed *monitoring the association of the consumable with the image forming device*.

Furthermore, the teachings of paragraph 0047 refer to operations which *occur after the printing*. Appellants respectfully submit that the teachings of the post-printing operations of paragraph 0047 fail to teach or suggest the claimed *monitoring the association of the consumable with the image forming device* in combination with the *enabling communication of the message responsive to the monitoring*. Indeed, the communication of paragraph 0047 *has already occurred* by the printing and paragraph 0047 of Shimbori fails to teach or suggest the claimed monitoring the association or the enabling communicating responsive to the monitoring as claimed.

Referring to page 3 of the Action, the Office relies upon the teachings of paragraph 0042 as allegedly teaching the claimed enabling. However, the operations of paragraph 0042 refer to operations after printing and fail to teach or suggest the claimed processor-usable medium comprising code configured to cause processing circuitry to perform *enabling communication of the marketing message to the user responsive to the monitoring of the association* as positively claimed. Also, the error message at step S210 informing the user to exchange the paper does not teach that the user has received the *marketing message* as stated on page 11 of the Action but teaches that the *error message* has been communicated to the user.

Referring to the suggestion by the Office in the last sentence of the first paragraph of page 11 of the final Office Action, Appellants respectfully submit that the originally filed claim 1 clearly already recites *enabling communication of the marketing message to the user responsive to the monitoring*.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

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B. Appellants respectfully submit that positively recited limitations of claims 8-19 and 22-24 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Referring to independent claim 8, the Office at page 4 of the Action relies upon the teachings of paragraph 0040 of Shimbori to teach the claimed providing. The Office at page 4 of the Action has failed to provide any explanation as to how the teachings of paragraph 0040 teach the claimed providing of claim 8. Appellants respectfully submit that the teachings of Shimbori including paragraph 0040 fail to teach or suggest providing the consumable usable in the image forming device to form hard images and additionally *to enable a marketing function with respect to image forming device users* in combination with the consumable being usable to form hard images.

Referring to page 12 of the Action, the Office states that paragraph 0040 describes a system for printing an advertisement for a user. The Office has failed to provide an explanation as to how the system of paragraph 0040 teaches the providing the consumable usable in the image forming device to form hard images and additionally to enable a marketing function with respect to image forming device users in combination with consumable being usable to form hard images.

Appellants also respectfully submit that the bald generic identification of paragraphs 0041 and 0042 of Shimbori by the Office and the allegation that the paragraphs describe the limitation is insufficient. The failure of the Office to identify teachings of the prior art which teach or suggest the claimed providing the consumable usable in the image forming device to form hard images and additionally *to enable a marking function with respect to image forming device users* in combination with consumable being usable to form hard images illustrates the improper nature of the 102 rejection.

Appellants respectfully submit that the Office has improperly relied upon the mere single function of using a consumable to print to allegedly teach plural different limitations of claim 8 of providing the consumable usable to form hard images and to enable a marking function.

Appellants respectfully submit the above limitations are not taught by Shimbori and the claims are allowable for at least this reason.

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Furthermore, the Office at page 4 of the Action relies upon the teachings of paragraph 0041 as allegedly disclosing the claimed *receiving the indication regarding a desirous party to utilize the marketing function* of claim 8. Applicants have failed to uncover any teaching in paragraph 0041 of receiving an indication regarding a desirous party *to utilize the marketing function which is enabled by the consumable* as defined in claim 8.

At page 12 of the Action, the Office states that paragraph 0041 teaches an advertiser desiring to send an advertisement to the user. Appellants have failed to uncover teachings in paragraph 0041 in support of the statement. In addition, the Office has failed to provide any explanation as to how such is considered to teach the claimed limitations of *receiving the indication regarding a desirous party to utilize the marketing function*.

Appellants respectfully submit the above limitations are not taught by Shimbori and claims are allowable for at least this reason.

Referring to page 12 of the Action, the Office identifies printing of advertisements on paper using an ink and states the such enables the marketing function to be displayed to the user. However, claim 8 also recites initiating the marketing function after the enabling. The Office at page 5 of the Action relies upon teachings in paragraph 0042 as teaching the claimed initiating. Appellants respectfully submit the actions of paragraph 0042 may not be fairly interpreted to teach the claimed initiating but are subsequent steps after the printing has already been started.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

C. Appellants respectfully submit that positively recited limitations of claims 20 and 25 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Claim 20 recites providing the *consumable* usable in the printer to print hard images and in addition to enable communication of a marketing message with respect to printer users. The bald identification of paragraph 0040 of Shimbori on

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page 8 of the Action fails to provide any explanation as to how the teachings of Shimbori are considered to teach the plural limitations of the providing the consumable usable to print images in combination with enabling communication of a marketing message.

Appellants respectfully submit that the Office has improperly relied upon the mere single function of using a consumable to print to allegedly teach plural different limitations of claim 20 of providing the *consumable* usable in the printer to *print hard images* and to *enable communication of a marketing message* with respect to printer users in addition to the printing hard images positively claimed in claim 20.

Appellants respectfully submit the above limitations are not taught by Shimbori and claims are allowable for at least this reason.

Furthermore, the Office at page 4 of the Action relies upon the teachings of paragraph 0041 as allegedly disclosing the claimed receiving the indication regarding a desirous party to utilize the marketing function. Applicants have failed to uncover any teaching in paragraph 0041 of receiving an indication regarding a desirous party to utilize the marketing function which is enabled by the consumable.

At page 12 of the Action, the Office states that paragraph 0041 teaches an advertiser desiring to send an advertisement to the user. Appellants have failed to uncover teachings in paragraph 0041 in support of the statement. In addition, the Office has failed to provide any explanation as to how such is considered to teach the claimed limitations of *receiving the indication regarding a desirous party to utilize the marketing function*.

Appellants respectfully submit the above limitations are not taught by Shimbori and claims are allowable for at least this reason.

Claim 20 also recites *enabling a marketing message using the consumable* in combination with *initiating communication of the marketing message*. The Office at page 9 of the Action merely recites paragraphs 0042 and 0070 of Shimbori as allegedly teaching the claimed enabling the marketing message using the consumable. The Office has failed to explain how the operations of 0042 and 0070 of Shimbori are considered to teach the claimed enabling, let alone the claimed enabling in combination with the claimed initiating communication.

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Appellants respectfully submit the above limitations are not taught by Shimbori and claims are allowable for at least this reason.

Claim 20 additionally recites detecting a triggering event with respect to a consumable and initiating communication of the marketing message using the printer responsive to the detecting. The Office at page 9 of the Action recites paragraphs 0070, 0073 and 0075 as allegedly teaching the claimed detecting and initiating without identification of the teachings relied upon as teaching detecting the triggering event or initiating communication of the marketing message. The teachings of paragraphs 0070, 0073 and 0075 have not been demonstrated to teach the claimed limitations.

At page 14 of the Action, the Office specifically identifies paragraph 0073 as allegedly teaching the claimed detecting. Paragraph 0073 teaches checking a number of sheets printed exceeding a predetermined number or limit. However, claim 20 also recites *initiating communication of the marketing message responsive to the detecting the triggering event*. The Office has failed to identify any teachings that Shimbori teaches initiating communication of the marketing message responsive to the detecting exceeding of the limit of paragraph 0073. To the contrary, Shimbori states at paragraph 0073 that unit 150 notifies unit 10 that the number of the printed sheets exceeds the limit so as to prevent printing which is contrary to initiating communication of the marketing message responsive to the detecting as positively claimed.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

D. Appellants respectfully submit that positively recited limitations of claim 2 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Referring to claim 2, the Office at page 11 of the Action relies upon inherency and paragraph 0044 of Shimbori in support of the 102 rejection. Appellants respectfully submit the reliance upon inherency is improper.

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In particular, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). MPEP 2112 IV (8th ed., rev. 5).

When properly considered in combination with the limitations of claim 1, claim 2 recites the processor-usable medium having code configured to cause processing circuitry to perform monitoring comprising monitoring coupling of the consumable and the image forming device and enabling the communication of the marketing message responsive to the monitoring.

The Office at page 11 of the Action relies upon the teachings of paragraph 0044 of Shimbori in support of the 102 rejection. Paragraph 0044 discloses monitoring capacity of a consumable and placing an order responsive to the capacity monitoring. Accordingly, Shimbori teaches monitoring capacity as opposed to monitoring a coupling of the consumable with the image forming device. Furthermore, the Office has not provided a basis in fact and/or technical reasoning that monitoring capacity is monitoring the coupling as claimed.

Furthermore, Shimbori at paragraph 0044 teaches ordering the consumable responsive to the monitoring capacity which fails to teach or suggest the claimed code configured to cause *processing circuitry to enable communication of the marketing message responsive to the monitoring of the coupling*.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

E. Appellants respectfully submit that positively recited limitations of claim 3 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Referring to claim 3, the *enabling comprises accessing the marketing message from a memory device of the consumable*. At page 3 of the Action, the Office relies upon paragraph 0042 of Shimbori in support of the rejection.

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Appellants have searched and failed to locate any reference to a *memory device* in paragraph 0042 of Shimbori let alone the claimed limitations reciting the *memory device of the consumable*.

Appellants have failed to locate teachings of accessing the marketing message from the memory device of the consumable as claimed. To the contrary, Shimbori expressly teaches at paragraph 0041 that the information sending apparatus 60 provides an advertisement on the Internet and the advertisement is shown resident on apparatus 60 in Fig. 1 and apart from the printer 50.

Furthermore, claim 3 recites that the enabling of the communication comprises accessing the marketing message from the memory device of the consumable while paragraph 0042 refers to actions after the advertisement has already been printed. The post printing activities of paragraph 0042 may not be fairly interpreted to teach or suggest the claimed limitations of claim 3 for enabling the communication of the marketing message including accessing the marketing message.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

F. Appellants respectfully submit that positively recited limitations of claim 4 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Referring to claim 4, the *enabling comprises accessing an identifier of the marketing message from a memory device of the consumable*. At page 3 of the Action, the Office relies upon paragraph 0043 of Shimbori in support of the rejection.

Appellants have searched and failed to locate any reference to a *memory device* in paragraph 0043 of Shimbori let alone the claimed limitations reciting the *memory device of the consumable*.

Appellants have failed to locate teachings of accessing an identifier of the marketing message from the memory device of the consumable as claimed.

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Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

G. Appellants respectfully submit that positively recited limitations of claim 21 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Claim 21 recites the media comprising code configured to cause the *processing circuitry to perform the steps* comprising monitoring an association of a consumable with an image forming device and *enabling the communication of the marketing message responsive to the monitoring detecting the association comprising installation of the consumable within the image forming device*. The Office at page 9 relies upon paragraph 0075 of Shimbori in support of the rejection. Paragraph 0075 is void of any teaching of the claimed monitoring *detecting installation of the consumable within the image forming device*. The detection of the type of paper for determining whether the paper is the same as the paper registered as the one the user uses in the database of Shimbori fails to teach or suggest detection of installation of the consumable within the image forming device or the enabling of the communication of the marketing message responsive to the detecting installation.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

H. Appellants respectfully submit that positively recited limitations of claims 12-15 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Claim 12 recites in combination with independent claim 8, *providing a consumable usable to enable a marketing function, enabling the marketing function, detecting a triggering event with respect to the consumable and initiating the marketing function responsive to the detecting*.

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The Office at page 5 of the Action relies upon the teachings of paragraph 0044 in support of the rejection of claim 12. Paragraph 0044 teaches checking a remaining amount of consumables and placing an order for consumables to avoid lack of consumables. The placing of the order for a consumable fails to teach or suggest *initiating the marketing function with respect to image forming device users responsive to detecting a triggering event with respect to the consumable* as defined in the claims.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

I. Appellants respectfully submit that positively recited limitations of claim 13 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Claim 13 recites in combination with independent claim 8 and dependent claim 12, *providing a consumable usable to enable a marketing function, enabling the marketing function, detecting a triggering event with respect to the consumable and initiating the marketing function comprising communicating a marketing message responsive to the detecting*. The Office identifies paragraph 0044 as teaching the claimed detecting of claim 12 and relies upon paragraph 0082 as teaching communicating a marketing message responsive to the detecting the triggering event.

Paragraph 0082 refers to selection of a party for ordering the consumables. Appellants respectfully submit that the *ordering of the consumables and selection of the party to order consumables* fails to teach or suggest the claimed *communicating the marketing message responsive to the detecting the triggering event with respect to the consumable*. Shimbori is void of any teaching or suggestion of initiating communication of the advertisement 60 responsive to detecting a triggering event with respect to the consumable.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

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J. Appellants respectfully submit that positively recited limitations of claim 14 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

The Office relies upon paragraph 0044 of Shimbori in support of the rejection. The checking of the remaining amount of consumables used by the printer fails to teach or suggest the claimed *detecting the triggering event comprising detecting coupling of the consumable with the image forming device* in combination with the *initiating the marketing function responsive to the detecting*.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

K. Appellants respectfully submit that positively recited limitations of claim 16 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Applicants have failed to uncover any teaching in paragraphs 0015-16 of Shimbori relied upon by the Office as teaching the claimed limitations of the *consumable comprising a memory device configured to store a marketing message*.

Appellants respectfully submit the above limitations are not taught by Shimbori and the claims are allowable for at least this reason.

Applicants have failed to uncover any teaching in paragraph 42 of Shimbori of the claimed *storing the marketing message using the memory device of the consumable*. Applicants have failed to uncover any teaching in paragraph 42 of the claimed *accessing the marketing message from the memory device*. To the contrary, Shimbori teaches the apparatus 60 separate from the printer as providing the advertisement.

Appellants respectfully submit the above limitations are not taught by Shimbori and the claims are allowable for at least this reason.

Referring to page 13 of the Action, the Office tortures the clear language of the claims in support of the rejection and states that the consumable could be a printer. Appellants respectfully submit that the torturing of the claimed language clearly illustrates the erroneous nature of the rejection. Such interpretation is

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contrary to the typical customary meaning of the term consumable and contrary to the use of consumable in the present application in paragraph 0022 including imaging media, marketing agents, components of the image forming device having a fixed life span (e.g., developer) and other expendable items utilized to complete desired jobs. Perhaps even more telling is that the interpretation is contrary to the use of the term "consumable" in paragraph 0044 of Shimbori being number of sheets of paper or remaining amount of ink. Shimbori also discloses a printer 50 which is different than the consumable. The Office has cited no evidence that the consumables of Shimbori teach or suggest the claimed limitations including the consumable comprising a memory device configured to store the marketing message, storing the marketing message using the marketing device and accessing the marketing message from the memory device.

Furthermore, claim 16 recites in combination with claim 8 *providing a consumable usable in an image forming device*. The interpretation of the Office requires a printer usable *in a computer* which is non-sensical and contrary to the explicit teachings of Shimbori using printer and consumable in customary definitions.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

L. Appellants respectfully submit that positively recited limitations of claim 17 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Referring to claim 17 and pages 7 and 13 of the Action, the Office has tortured the meaning of commonly understood terms to arrive at the anticipation rejection. The Office alleges that the printer is a consumable. As stated above, this interpretation is contrary to the customary meaning of the terms, explicit teachings of Shimbori and the usage of the terms in the present application. The tortured meanings of the understood terms and contrary to the teachings of Shimbori illustrate the erroneous nature of the rejection of claim 17. Furthermore, the use of memory device in claim 17 is consistent with well-understood meanings of memory

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understood in the art and is not "very broad" to include paper as alleged by the Office on page 7 of the Action. The Office has pointed to no teaching that Applicants intend the memory device of claim 17 to be broader than the ordinarily understood meaning of memory or memory device. The Office has pointed to no evidence that memory or memory device has ever been interpreted to include paper.

Shimbori clearly defines consumables as being paper or ink and the Office has failed to point to any teaching that the paper or ink of Shimbori comprises a memory device.

Shimbori further fails to teach or suggest other numerous limitations of claim 17. For example, Shimbori fails to disclose or suggest the claimed *storing an identifier within the memory device to identify the marketing function*, accessing the identifier, *first communicating the identifier externally of the image forming device* to identify the marketing function comprising a marketing message, *receiving the marketing message within the image forming device responsive to the first communicating*, and the second communicating the marketing message using the image forming device. Claim 17 is allowable for the numerous compelling above-identified reasons.

Appellants also submit the reliance upon inherency is misplaced inasmuch as the Office has failed to establish that the claimed limitations necessarily flow from the teachings of the prior art as is required for proper reliance upon inherency. Shimbori teaches the advertisement resident at device 60 and communicated to the terminal unit 10 and printed using printer 50. The arrangement of Shimbori fails to teach the accessing the identifier from the memory device of the consumable, the communicating the identifier externally of the image forming device, or the receiving the marketing message within the image forming device responsive to the communicating the identifier. The Office has failed to provide any basis in fact or technical reasoning that these limitations necessarily flow from the teachings of Shimbori but to the contrary Shimbori provides an entirely different arrangement for printing of the advertisement 60.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

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M. Appellants respectfully submit that positively recited limitations of claim 18 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

Claim 18 recites *monitoring a consumable utilizing an external device with respect to the image forming device and forwarding a marketing message to the image forming device utilizing the external device responsive to the detecting the status* and further comprising *communicating the marketing message using image forming device responsive to the detecting the status*.

Shimbori at paragraph 0079 teaches the unit 210 of the printer checking the remaining amount of the consumable which fails to teach the *monitoring the consumable utilizing an external device with respect to the image forming device*.

Appellants respectfully submit the above limitations are not taught by Shimbori and the claims are allowable for at least this reason.

Paragraph 0041 fails to teach or suggest the claimed *forwarding the marketing message to the image forming device responsive to the detecting status of the consumable*.

Appellants respectfully submit the above limitations are not taught by Shimbori and the claims are allowable for at least this reason.

Paragraph 0042 fails to teach or suggest the claimed *communicating the marketing message using image forming device responsive to the detecting the status of the consumable*.

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

N. Appellants respectfully submit that positively recited limitations of claim 19 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

The teachings of paragraph 0070 of Shimbori with respect to printing managing apparatus 30 and terminal unit 10 fail to teach or suggest the limitations of claim 19 defining *electrical storage space of a memory device of a consumable*.

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Furthermore, the teachings of Shimbori fail to teach or suggest *offering electrical storage space of the memory device of the consumable to other parties.*

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

O. Appellants respectfully submit that positively recited limitations of claim 22 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

The teachings of paragraph 0070 of Shimbori with respect to printing managing apparatus 30 and terminal unit 10 fail to teach or suggest the limitations of claim 22 reciting *storing electrical data related to the marketing function using an electrical memory device of the consumable.*

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

P. Appellants respectfully submit that positively recited limitations of claim 23 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

The teachings of paragraph 0070 of Shimbori with respect to printing managing apparatus 30 and terminal unit 10 fail to teach or suggest the limitations of claim 23 reciting *storing a marketing message in the form of electrical data using an electrical memory device of the consumable.*

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

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Q. Appellants respectfully submit that positively recited limitations of claim 24 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

The teachings of paragraph 0070 of Shimbori with respect to printing managing apparatus 30 and terminal unit 10 and the detection of the paper of paragraph 0075 of Shimbori fail to teach or suggest the limitations of claim 24 reciting *storing electrical data of the identifier within the memory device of the consumable comprising an electrical memory device configured to store the electrical data.*

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

R. Appellants respectfully submit that positively recited limitations of claim 25 are not disclosed nor suggested by Shimbori and the 102 rejection is improper for at least this reason.

The teachings of Shimbori disclose ordering a consumable responsive to monitoring of the consumable, preventing printing if a number of sheets exceeds a predetermined number of sheets or checking the type of paper in the printer to determine if it matches the user paper. The teachings of Shimbori fail to disclose or suggest the claimed *detecting a triggering event with respect to the consumable* in combination with the claimed *initiating printing of the marketing message using the printer responsive to the detecting the triggering event.*

Appellants respectfully submit that positively-recited limitations of the claims are not disclosed by Shimbori and Appellants respectfully request reversal of the rejections for at least this reason.

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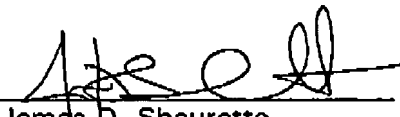
S. Conclusion

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

Respectfully submitted,

Date: 5/14/07

Attorney:


James D. Shaurette
Reg. No. 39,833

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VIII. APPENDIX A – THE CLAIMS INVOLVED IN THIS APPEAL

1 1. [Original] An article of manufacture comprising:
2 a processor-usable medium having processor-useable code embodied
3 therein and configured to cause processing circuitry to perform steps
4 comprising:
5 providing a marketing message intended for an image forming
6 device user from a party other than a provider of a consumable;
7 monitoring an association of a consumable with an image forming
8 device; and
9 enabling communication of the marketing message to the image
10 forming device user responsive to the monitoring.

1 2. [Original] The article of claim 1 wherein the monitoring comprises
2 monitoring coupling of the consumable and the image forming device.

1 3. [Previously Presented] The article of claim 1 wherein the enabling
2 comprises accessing the marketing message from a memory device of the
3 consumable.

1 4. [Previously Presented] The article of claim 1 wherein the enabling
2 comprises accessing an identifier of the marketing message from a memory
3 device of the consumable.

1 5. [Original] The article of claim 1 wherein the enabling comprises
2 communicating the marketing message to the image forming device.

1 6. [Original] The article of claim 1 wherein the providing comprises
2 providing the marketing message comprising a message unrelated to the
3 consumable and unrelated to the image forming device.

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1 7. [Original] The article of claim 1 wherein the code is further
2 configured to cause the processing circuitry to perform the step including
3 offering the marketing message to parties other than providers of the
4 consumable and the providing is responsive to the offering.

1 8. [Previously Presented] A marketing method to image forming
2 device users comprising:
3 providing a consumable usable in an image forming device to form hard
4 images and usable to enable a marketing function with respect to image forming
5 device users;
6 making available the marketing function to other parties apart from a
7 provider of the consumables;
8 receiving an indication regarding a desirous party to utilize the marketing
9 function;
10 enabling the marketing function for the desirous party using the
11 consumable; and
12 initiating the marketing function after the enabling.

1 9. [Original] The method of claim 8 wherein the initiating the
2 marketing function comprises communicating a marketing message for the
3 desirous party using the image forming device.

1 10. [Original] The method of claim 9 wherein the communicating
2 comprises communicating the marketing message comprising a message
3 unrelated to the consumable and unrelated to the image forming device.

1 11. [Original] The method of claim 8 wherein the initiating comprises
2 communicating a marketing message using an image forming device.

1 12. [Original] The method of claim 8 further comprising detecting a
2 triggering event with respect to the consumable, and wherein the initiating is
3 responsive to the detecting.

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1 13 [Original] The method of claim 12 wherein the initiating comprises
2 communicating a marketing message.

1 14. [Original] The method of claim 12 wherein the detecting the
2 triggering event comprises detecting coupling of the consumable with an image
3 forming device.

1 15. [Original] The method of claim 12 wherein the detecting the
2 triggering event comprises detecting a condition of the consumable reaching a
3 predetermined level.

1 16. [Original] The method of claim 8 wherein the providing the
2 consumable comprises providing the consumable configured to enable the
3 marketing function comprising communication of a marketing message
4 associated with the desirous party, and the consumable comprises a memory
5 device configured to store the marketing message, and the enabling comprises
6 storing the marketing message using the memory device and the initiating
7 comprises accessing the marketing message from the memory device and
8 communicating the marketing message using the image forming device after the
9 accessing.

1 17. [Original] The method of claim 8 wherein the consumable
2 comprises a memory device, and the enabling comprises storing an identifier
3 within the memory device to identify the marketing function for the desirous
4 party, and the initiating comprises accessing the identifier, and further
5 comprising:
6 associating the consumable with an image forming device;
7 first communicating the identifier externally of the image forming device
8 to identify the marketing function comprising a marketing message for the
9 desirous party after the associating;
10 receiving a marketing message within the image forming device
11 responsive to the first communicating; and

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12 second communicating the marketing message using the image forming
13 device.

1 18. [Previously Presented] The method of claim 8 wherein the enabling
2 comprises monitoring the consumable utilizing an external device with respect to
3 the image forming device, and further comprising detecting a status of the
4 consumable reaching a predetermined status, and wherein the initiating the
5 marketing function comprises forwarding a marketing message to the image
6 forming device utilizing the external device responsive to the detecting the
7 status, and further comprising communicating the marketing message using the
8 image forming device responsive to the detecting the status.

1 19. [Previously Presented] The method of claim 8 wherein the making
2 available comprises offering electrical storage space of a memory device of a
3 consumable to the other parties.

1 20. [Original] A marketing method to printer users comprising:
2 providing a consumable usable in a printer to print hard images and usable
3 to enable communication of a marketing message with respect to printer users;
4 offering the contents of the marketing message to other parties apart
5 from a provider of the consumables;
6 receiving an indication regarding a desirous party to utilize the marketing
7 message;
8 enabling a marketing message for the desirous party using the
9 consumable and wherein the marketing message is unrelated to the printer and
10 unrelated to the consumable;
11 detecting a triggering event with respect to the consumable after the
12 associating; and
13 initiating communication of the marketing message using the printer
14 responsive to the detecting.

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1 21. [Previously Presented] The article of claim 1 wherein the enabling
2 comprises enabling responsive to the monitoring detecting the association
3 comprising installation of the consumable within the image forming device.

1 22. [Previously Presented] The method of claim 8 wherein the enabling
2 comprises storing electrical data related to the marketing function using an
3 electrical memory device of the consumable.

1 23. [Previously Presented] The method of claim 8 wherein the enabling
2 the marketing function comprises storing a marketing message in the form of
3 electrical data using an electrical memory device of the consumable.

1 24. [Previously Presented] The method of claim 17 wherein the
2 enabling comprises storing electrical data of the identifier within the memory
3 device comprising an electrical memory device configured to store the electrical
4 data.

1 25. [Previously Presented] The method of claim 20 wherein the
2 initiating communication comprises initiating printing of the marketing message
3 using the printer.

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IX. APPENDIX B – EVIDENCE APPENDIX

Appellants submit no evidence with the appellate brief.

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X. APPENDIX C - RELATED PROCEEDINGS

Appellants are not aware of any related proceedings.

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